

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/758,242 Confirmation No. : 5321
First Named Inventor : Bernd SUNDERMANN
Filed : January 16, 2004
TC/A.U. : 1621
Examiner : Brian J. Davis
Docket No. : 029310.53136US
Customer No. : 23911
Title : Substituted 4-Aminocyclohexanols

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INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97 AND 1.98

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. § 1.56, the attached Form PTO/SB/08 lists a document which the Examiner may deem relevant to patentability of the claims of the above-identified application.

I. Time Period of Submission

This Information Disclosure Statement is submitted:

☐ 1) no later than three months from the application's filing date or 2) before the mailing date of the first Office Action on the merits (whichever is later) or 3) before a first Office Action after the filing of a Request for Continued Examination, and therefore no statement under 37 C.F.R. § 1.97(e) or fee under 37 C.F.R. § 1.17(p) is required.

☐ 2) after the later of three months from the application's filing date and the mailing date of the first Office Action on the merits, but before a Final Office Action, a Notice of Allowance, or an action closing prosecution (*Ex parte Quayle*), (whichever is earlier), and therefore Applicant is filing concurrently herewith:

☐ a Statement under 37 C.F.R. § 1.97(e); or

☐ a fee in the amount of \$180.00 under 37 C.F.R. § 1.17(p).

☐ 3) after either a Final Office Action or a Notice of Allowance, but before payment of the Issue Fee, and therefore Applicant is submitting herewith:

a Statement under 37 C.F.R. § 1.97(e); and

a fee in the amount of \$180.00 under 37 C.F.R. § 1.17(p).

☒ 4) Other: A copy of reference AM was originally submitted for consideration on September 8, 2004. Applicants mistakenly left out some of the required information (37 CFR § 1.98(A)(1)). Applicants hereby resubmit the listing of the document with all required information as is available. Applicants believe that because this document was originally submitted to the office prior to any action from the Examiner, no fee is due. As a courtesy to the Examiner, Applicants submit herewith a duplicate copy of the listed reference.

II. Statement Under 37 C.F.R. § 1.97(e)

☐ I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement; or

☐ I hereby state that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making a reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement; or

III. Statement under 37 C.F.R. § 1.704(d)

☐ I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this Information Disclosure Statement.

IV. Submission of Non-English Language Documents

☐ The following is a concise explanation of relevance of the non-English language documents listed in the attached Form PTO/SB/08:

☐ The relevance of document(s) _____ to the subject matter of the present invention is/are provided in the specification of the above-identified application.

☐ Corresponding foreign or international report(s) citing document(s) _____, together with an English-language version(s) (if not already in English) of that portion of the report(s) indicating the degree of relevance found by the foreign office(s) is/are submitted.

☐ English language family member publication(s) of document(s) _____ is/are noted on Form PTO/SB/08.

☐ English language abstract(s) is/are submitted for document(s) _____.

☐ English translation(s) of the foreign language document(s) _____ is/are submitted herewith.


☐ Applicant submits the following explanations: _____.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

If necessary, this paper should be considered as an authorization to charge Deposit Account 05-1323, Attorney Docket No.: 029310.53136US, for the fee set forth in 37 C.F.R. § 1.17(p).

April 4, 2006

Respectfully submitted,



J. D. Evans

Registration No. 26,269

Christopher T. McWhinney

Registration No. 42,875

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:CTM:mdm (2747311)

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence consisting of 10 pages is being filed by facsimile transmission to the U.S. Patent and Trademark Office, (571) 273-8300, on the date shown below.

Signature

Christopher T. McWhinney

Date

April 4, 2006

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Substitute for form 1449B/PTO
INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

Complete if Known

Application Number	10/758,242
Filing Date	January 16, 2004
First Named Inventor	Bernd SUNDERMANN
Group Art Unit	1621
Examiner Name	Brian J. Davis
Attorney Docket Number	029310.53136US

Sheet	1	of	1
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Examiner
Initials*Cite
No.¹

Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.

7

AM

VON VOIGTLANDER et al., "4-Aryl-4-Aminocyclohexanone Derivatives: A Chemically Novel Series of Analgesics Including Opioid Antagonists and Extremely Potent Agonists," Endog. Exog. Opiate Agonists Antagonists, Proc. Int. Narc. Res. Club. Conf., 1980 (Meeting Date 1979), pp. 17 - 21, Pergamon, Elmsford, NY, USA

**Examiner
Signature**

Date Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. *Applicant is to place a check mark here if English language translation is attached.

Normal Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.**

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